

counsel jointly and severally liable for payment to Mor-Flo of the damages we assess.

CONCLUSION

For the foregoing reasons, the judgment appealed from is affirmed. Because State has shown no arguable basis in law or fact for reversal, and has argued its appeal with distortion and disregard of the record and the controlling law, we deem the appeal to have been frivolous as filed and frivolous as argued, and grant Mor-Flo's request for sanctions under Fed. R. App. P. 38. Therefore, Mor-Flo is awarded the sum of \$5,000 as damages for defending this frivolous appeal, for the payment of which State and its counsel are jointly and severally liable.

AFFIRMED — SANCTIONS IMPOSED.

Court of Appeals, Federal Circuit

Continental Can Co. USA Inc. v. Monsanto Co.

No. 90-1328

Decided November 13, 1991

JUDICIAL PRACTICE AND PROCEDURE

1. Procedure — Summary judgment — Patents (§410.3303)

Summary judgment is as available in patent cases as in other areas of litigation and can facilitate disposition of legally meritless suits, but improvident grant of summary judgment can prolong litigation and increase its burdens, especially in patent disputes in which patent property is wasting asset.

PATENTS

2. Patentability/Validity — Anticipation — In general (§115.0701)

Anticipation under 35 USC 102 cannot be found if more than one reference is required

the brief."); *Browning Debenture Holders' Comm. v. DASA Corp.*, 605 F.2d 35, 41 (2d Cir. 1978); *Hilmon*, 899 F.2d at 254 (collecting cases); *Coghlan*, 852 F.2d at 817-18; *TIF Instr. Inc. v. Colette*, 713 F.2d 197, 201 (6th Cir. 1983) (Nies, J., sitting by designation); *Hatch v. Reliance Ins. Co.*, 758 F.2d 409, 416 (9th Cir.), cert. denied, 474 U.S. 1021 (1985); *Braley*, 832 F.2d at 1511 (collecting cases); *Saltany v. Reagan*, 886 F.2d 438, 441 (D.C. Cir. 1989), cert. denied, 110 S.Ct. 2172 (1990).

to establish unpatentability of claimed invention; rather, validity in such case is determined pursuant to 35 USC 103.

3. Patentability/Validity — Anticipation — Prior art (§115.0703)

Patent construction — Claims — Defining terms (§125.1305)

Federal district court erred by ruling, on summary judgment, that claims for patented bottle were anticipated by prior art, since court erred in its construction of claim term "hollow," and since disputed issue of fact exists as to whether injection blow molding process necessarily produced "hollow" ribs in prior art base structure, as term "hollow" is used in patent.

4. Patentability/Validity — Anticipation — Prior sale — In general (§115.0707.01)

"On sale" bar of 35 USC 102(b) does not arise simply because intended customer was participating in development and testing, but rather all circumstances concerning relationship between patentee and customer must be considered in light of public policy underlying Section 102(b); thus, federal district court erred in determining that bottle was "on sale," in view of evidence showing that bottle was part of terminated development project that never bore commercial fruit and was cloaked in confidentiality.

5. Patentability/Validity — Obviousness — Combining references (§115.0905)

Federal district court erred by ruling, on summary judgment, that claimed bottom structure for plastic container was obvious, since, drawing all reasonable inferences in favor of patentee, it has not been established that person skilled in art would be motivated to select and combine features from each prior art source to make patented base.

6. Patentability/Validity — Obviousness — Secondary considerations generally (§115.0907)

Differences between patented invention and prior art which may appear technologically minor nonetheless can have practical impact, particularly in crowded field, and in such case objective indicia, such as commercial success, or filling existing need, illuminate technological and commercial environment of inventor, and aid in understanding state of art at time invention was made.

7. Patentability/Validity — Obviousness — Commercial success (§115.0908)

Patented invention need not be solely responsible for commercial success in order for this factor to be given appropriate weight.

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patentability of claimed invention in such case is determined to 35 USC 103.

Validity — Anticipation — (§115.0703)

Conclusion — Claims — Defining (25.1305)

district court erred by ruling, on remand, that claims for patented structure anticipated by prior art, since its construction of claim term "ribbed" since disputed issue of fact whether injection blow molding process produced "hollow" ribs or structure, as term "hollow" meant.

Validity — Anticipation — In general (§115.0707.01)

Article of 35 USC 102(b) does not excuse intended customer was in development and testing, but instances concerning relationship between patentee and customer must be in light of public policy underlying 102(b); thus, federal district court determining that bottle was in view of evidence showing that art of terminated development never bore commercial fruit and no confidentiality.

Validity — Obviousness — In light of references (§115.0905)

district court erred by ruling, on remand, that claimed bottom structure of plastic container was obvious, given all reasonable inferences in the art, it has not been established that the claimed structure would be motivated to combine features from each reference to make patented base.

Validity — Obviousness — Primary considerations generally (25.07)

There is no evidence between patented invention and prior art which may appear technological, nonetheless can have practical significance in crowded field, and in effective indicia, such as commercial success, long-felt need, illuminating and commercial environment, and aid in understanding the time invention was made.

Validity — Obviousness — Commercial success (§115.0908)

Invention need not be solely for commercial success in order for it to be given appropriate weight.

Particular patents — General and mechanical — Plastic bottle

4,108,324, Krishnakumar, Roy, Pocock, Das, and Mahajan, ribbed beverage bottle structure for plastic container created by plastic hot-fill, summary judgment of invalidity vacated in part, reversed in part, and remanded.

Appeal from the U.S. District Court for the Southern District of Ohio, Spiegel, J.; 11 USPQ2d 1761.

Patent infringement action brought by Continental Can Co. USA Inc. and Continental Pet Technologies Inc. against Monsanto Co., Hoover Universal Inc., and Johnson Controls Inc. From federal district court decision entering summary judgment in favor of defendants, plaintiffs appeal. Vacated in part, reversed in part, and remanded.

Eugene F. Friedman, Chicago, Ill. (Edwin C. Thomas, III and David M. Novak, of Bell, Boyd & Lloyd, Chicago; Kurt L. Grossman, of Wood, Herron & Evans, Cincinnati, Ohio, with him on brief), for plaintiff-appellants.

Henry J. Renk, New York, N.Y. (Lawrence F. Scinto and Bruce C. Haas, of Fitzpatrick, Cella, Harper & Scinto, New York; Jacob K. Stein and Deborah DeLong, of Thompson, Hine & Flory, Cincinnati, Ohio; Lawrence L. Limpus, St. Louis, Mo., and Edward L. Levine, Milwaukee, Wis., with him on brief), for defendants-appellees.

Before Newman, Archer, and Rader, circuit judges.

Newman, J.

Continental Can Company USA and Continental PET Technologies (collectively "Continental") appeal the partial summary judgment of the United States District Court for the Southern District of Ohio, holding that United States Patent No. 4,108,324 (the "Conobase" or '324 patent) is invalid. Final judgment was entered on this issue, for the purpose of appeal.

Summary Judgment

An issue may be decided on motion for summary judgment when there is no genuine

Continental Can Co. USA v. Monsanto Co., 11 USPQ2d 1761 (S.D. Ohio 1989), *reconsidered*, No. C-1-86-1213 (S.D. Ohio Nov. 9, 1989).

issue of material fact, and the movant is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986); *Celotex Corp. v. Catrett*, 477 U.S. 317, 325-26 (1986); *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1571, 18 USPQ2d 1001, 1005 (Fed. Cir. 1991). The movant's burden is to show that no fact material to the issue is in dispute, that even if all material factual inferences are drawn in favor of the non-movant the movant is entitled to judgment as a matter of law. *Id.* Summary judgment is as available in patent cases as in other areas of litigation. *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 713 F.2d 774, 778-79, 218 USPQ 673, 675 (Fed. Cir. 1983).

The purpose of the summary process is to avoid a clearly unnecessary trial. *Matsushita Elec. Industrial Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986); it is not designed to substitute lawyers' advocacy for evidence, or affidavits for examination before the fact-finder, when there is a genuine issue for trial. As stated in *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 176 (1970) (Black, J., concurring), "[t]he right to confront, cross-examine and impeach adverse witnesses is one of the most fundamental rights sought to be preserved by the Seventh Amendment". See also *Poller v. Columbia Broadcasting System, Inc.*, 368 U.S. 464, 473 (1962).

[1] While facilitating the disposition of legally meritless suits, when summary judgment is improvidently granted the effect is to prolong litigation and increase its burdens. This is of particular concern in patent disputes, where the patent property is a wasting asset, and justice is ill served by delay in final resolution. In the case at bar, although some issues could be resolved on the law and undisputed facts, other issues require trial.

The Patented Invention

The '324 patent, entitled "Ribbed Bottom Structure for Plastic Container", inventors Suppayan M. Krishnakumar, Siegfried S. Roy, John F. E. Pocock, Salil K. Das, and Gautam K. Mahajan, is directed to a plastic bottle whose bottom structure has sufficient flexibility to impart improved impact resistance, combined with sufficient rigidity to resist deformation under internal pressure. The patented bottle is said to provide a superior combination of these properties. The bottom structure is illustrated as follows:

cessor in this business, Hoo-
Inc. and Hoover's parent com-
Controls (collectively "Mon-
nsanto moved for partial
ment based on issues of valid-
J.S.C. §§ 102 and 103.

35 U.S.C. § 102(a)
ory requirement that a patented
"new" is tested in accordance
C. § 102(a), which provides

A person shall be entitled to a
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nvention was known or used by
his country, or patented or de-
a printed publication in this or a
untry, before the invention
the applicant for patent. . . .
ourt found that all the claims of
ent were anticipated by U.S.
1,468,443 (the Marcus patent).
that the district court erred in
etation, and also found disputed
ly to the nonmovant, thus inap-
eciding the issue summarily.
ation under § 102(a) requires
tical invention that is claimed
ly known to others and thus is
pps Clinic, 927 F.2d at 1576, 18
1010; Titanium Metals Corp. of
mer, 778 F.2d 775, 780, 227
777-78 (Fed. Cir. 1985); Linde-
inenfabrik GmbH v. American
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81, 485 (Fed. Cir. 1984). When
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tability of the claimed invention
under § 102 can not be found,
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onsanto's burden to show that
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s ribs that are not hollow, as that
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to other differences between the
and the description in the Mar-

cus patent rib structure is illus-
figure 5 and in cross-section in

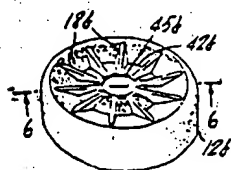


FIG. 5

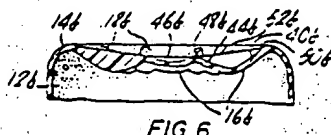


FIG. 6

The Marcus patent does not state that its ribs are "hollow", or use a similar term. Continental's witnesses testified by deposition that the Marcus patent shows solid, not hollow, ribs. A witness (Adomaitis) had stated in an internal memorandum written at Continental in 1969, well before this litigation arose, that "the ribs of their [Marcus'] web can be made of solid beams only." Another witness, '324 co-inventor Pocock, testified that:

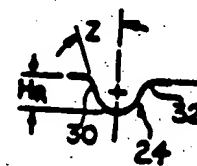
It seems evident to me that he [Marcus] was trying to produce some kind of container integrity by the production of essentially solid ribs on the bottom of the bottle. It seems to go to great length here to illustrate them as such.

Krishnakumar, another co-inventor, testified that it "is very obvious the ribs are shown solid", and that Figures 5 and 6 as well as Figures 7 through 12 of the Marcus patent all show solid ribs. However, Marcus, testifying for Monsanto, testified that his ribs were hollow, and that conventional blow molding would inherently produce hollow ribs.

The district court defined "hollow" as meaning that "the inside contour of the ribs generally follows the outside contour thereof," a definition on which the parties agreed. Continental, 11 USPQ2d at 1764. See the court's opinion, 11 USPQ2d at 1764-68, for various sketches made by the witnesses. Continental states that the district court erred in construing "hollow", and that the phrase "characterized by the feature that the ribs are hollow" must be construed in terms of the patent in which it appears. See, e.g., Tandon Corp. v. United States Int'l Trade Comm'n, 831 F.2d 1017, 1021, 4 USPQ2d 1283, 1286 (Fed. Cir. 1987). The '324 patent explicitly distinguished the Marcus teachings, stating that the '324 ribs are, unlike Marcus, not filled with plastic. The '324 specification uses the term "hollow", as do the prosecution history and the claims, for this purpose. The '324 patent's usage of

"hollow" is illustrated in rib cross-section in Figure 5A:

FIG-5A



The Marcus patent's rib structure thus was explicitly differentiated by the term "hollow" as used in the '324 specification, drawings, and prosecution history. Since the claim term must be construed as used by the patentee, the district court erred in its construction of the '324 claim term "hollow". On correct claim construction, the factual question of anticipation must be decided.

Monsanto's argument is that hollow ribs were inherently produced by Marcus. Monsanto thus argues that anticipation lies because the Marcus patent's ribs are "inherently" hollow, regardless of how they are shown in the Marcus patent. Monsanto argues that because the Marcus ribs are formed by injection blow molding, which is the same process described for the Conobase '324 ribs, hollow ribs are inherently disclosed in the Marcus patent.

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) provides:

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

This modest flexibility in the rule that "anticipation" requires that every element of the claims appear in a single reference accommodates situations where the common knowledge of technologists is not recorded in the reference; that is, where technological

facts are known to those in the field of the invention, albeit not known to judges. It is not, however, a substitute for determination of patentability in terms of § 103.

[3] Continental does not dispute the applicability of the injection blow molding process. However, Continental disputes the material of fact of whether this process necessarily produced "hollow" ribs in the Marcus base structure, as the term "hollow" is used in the '324 patent. Resolution of this disputed fact adversely to Continental was improper on summary judgment. The grant of summary judgment of anticipation under § 102(a) is vacated. The issue requires trial.

II

35 U.S.C. § 102(b)

The district court also held that the Marcus bottle was on sale, 35 U.S.C. § 102(b). Section 102(b) bars entitlement to a patent when:

(b) the invention was . . . in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States. . . .

The Marcus bottle was developed some ten years before the filing date of the '324 patent, during a project wherein Marcus' employer, Admiral Plastics or APL Corporation, entered into agreements with the Coca-Cola Company for the development of a suitable plastic bottle. The agreements provided that Admiral Plastics would make and Coca-Cola would test the bottles, and that if a satisfactory bottle was developed it would be manufactured by Admiral and purchased by Coca-Cola. Minimum commercial quantities and maximum commercial prices were stated in an agreement, and costs were a matter of discussion. Admiral produced a variety of bottle shapes, including the Marcus bottle. The project was terminated after about two years, because the "mechanical performance" requirements were not met as Coca-Cola wrote at the time.

[4] The district court reasoned that this project "called for the eventual marketing of the Marcus bottles once all technical difficulties were resolved", *Continental*, 11 USPQ2d at 1766, and on this basis held that the Marcus bottles were on sale. This holding was in error, for the "on sale" bar of § 102(b) does not arise simply because the intended customer was participating in development and testing. See *Great Northern Corp. v. Davis Core & Pad Co.*, 782 F.2d 159, 164-65, 228 USPQ 356, 358 (Fed. Cir. 1986). In *Baker Oil Tools, Inc. v. Geo Vann, Inc.*, 828 F.2d 1558, 1563-65, 4 USPQ2d

1210, 1213-15 (Fed. Cir. 1987), this court summarized various factors pertinent to the "on sale" bar when there is an issue concerning the relationship between the patentee and the customer: for example, whether there was a need for testing by other than the patentee; the amount of control exercised; the stage of development of the invention; whether payments were made and the basis thereof; whether confidentiality was required; and whether technological changes were made. All of the circumstances attending the relationship must be considered in light of the public policy underlying § 102(b). *UMC Electronics Co. v. United States*, 816 F.2d 647, 656, 2 USPQ2d 1465, 1471-72 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1025 (1988).

The district court acknowledged that all technical difficulties were not resolved and that no sales were ever made. Although Admiral Plastics' hope was surely commercial sales, and the record shows that prices and quantities were discussed, this does not of itself place the subject matter "on sale" in the sense of § 102(b). The Marcus bottle was part of a terminated development project that never bore commercial fruit and was cloaked in confidentiality. While the line is not always bright between development and being on sale, see generally *UMC Electronics, supra*, in this case the line was not crossed. The "on sale" bar is measured by "the time the public came into possession of the invention", *id.* at 655, 2 USPQ2d at 1471 (quoting *In re Foster*, 343 F.2d 980, 987-88, 145 USPQ 166, 173 (CCPA 1965), *cert. denied*, 383 U.S. 966 [149 USPQ 906] (1966) ("What starts the period running is clearly the availability of the invention to the public through the categories of disclosure enumerated in 102(b). . . ." (emphasis in original))). We conclude that the district court erred in holding that the circumstances that here existed placed the Marcus bottles "on sale" in terms of § 102(b). We therefore reverse and direct that on remand judgment on this issue shall be entered in favor of Continental, as a matter of law.

III

35 U.S.C. § 103

Obviousness, 35 U.S.C. § 103, is reviewed as a legal conclusion based upon underlying facts of four general categories, *viz.* the scope and content of the prior art, the differences between the prior art and the claimed invention, the level of ordinary skill at the time the invention was made, and any objective considerations that may be present. *Grain*

5 (Fed. Cir. 1987), this court various factors pertinent to the when there is an issue concerning relationship between the patentee and the prior art: for example, whether the invention was tested by other than the patentee; the amount of control exercised; the development of the invention; the efforts made and the basis for the invention; whether confidentiality was maintained; whether technological changes in the art; and the circumstances attending the invention. All of the circumstances attending the invention must be considered in light of the public policy underlying § 102(b). *C. Electronics Co. v. United States*, 725 F.2d 647, 656, 2 USPQ2d 1465, 151 (Fed. Cir. 1987), cert. denied, 484 U.S. 988.

The court acknowledged that all the facts were not resolved and that the invention was never made. Although Adams' hope was surely commercial success, the record shows that prices and the invention were discussed, this does not of itself make the subject matter "on sale" in light of § 102(b). The Marcus bottle was a commercial development project for a commercial fruit and was confidential. While the line is tight between development and invention, see generally *UMC Electronics v. United States*, in this case the line was not crossed. "on sale" bar is measured by whether the invention came into possession of the public. *Id.* at 655, 2 USPQ2d at 1471. *E. Foster*, 343 F.2d 980, 987-88, 166, 173 (CCPA 1965), cert. denied, 378 U.S. 966 [149 USPQ 906]. That starts the period running for the availability of the invention to the public. The categories of disclosure in § 102(b) are "in public" (emphasis in original). We conclude that the district court's holding that the circumstances did not place the Marcus bottle in the public domain is correct. We therefore affirm the district court's judgment that the invention shall be entered in favor of the patentee as a matter of law.

III

35 U.S.C. § 103

Under 35 U.S.C. § 103, is reviewed the inclusion based upon underlying prior art. The general categories, viz., the invention of the prior art, the difference between the prior art and the claimed invention, the level of ordinary skill at the time the invention was made, and any objections that may be present. *Graham v. John Deere Co.*, 383 U.S. 1, 17 [148 USPQ 459] (1966); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1137-38; 227 USPQ 543, 547 (Fed. Cir. 1985).

ham v. John Deere Co., 383 U.S. 1, 17 [148 USPQ 459] (1966); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1137-38; 227 USPQ 543, 547 (Fed. Cir. 1985).

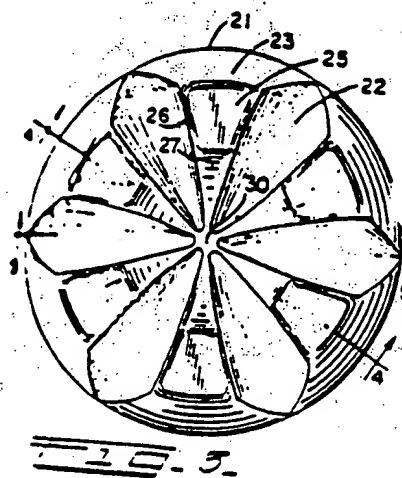
[5] The parties agreed that the scope and content of the prior art was adequately represented by four references: the Marcus patent discussed in Part I *ante*; a patent to Colombo (U.S. Patent No. 3,403,804), and two patents owned by Continental, U.S. Patent No. 3,598,270 (the Petaloid patent), and No. 3,935,955 (the Decaloid patent). They agreed on little else. In granting summary judgment of invalidity for obviousness, the district court found certain disputed material facts and misapplied certain precepts of law. We conclude that the issue was not amenable to summary resolution. Although it is not entirely clear how the references were combined by the court, we shall review the references briefly, in order to explain our conclusion.

The Petaloid Patent

The district court referred to the deposition testimony of Siegfried Roy, one of the co-inventors of the '324 patent, that the Petaloid base, inverted, was similar to the Conobase. Continental points out that neither Roy nor any other deponent suggested that the Petaloid base could be or should be inverted, or that inversion would provide an improved base structure. In *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) this court held that although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down.

Continental points out that the Petaloid description differs in several other ways from the '324 invention. In the '324 structure the outer end of each rib is lower than the inner end; whereas in the Petaloid structure the outer ends of the ribs are higher than the inner ends; that is, the ribs in the Petaloid base extend upward from the center to the sidewall. The Petaloid bottle is supported on feet extending between the ribs, such feet being the locations for stress concentrations. The following drawing is from the Petaloid patent:

Continental states that the '324 Conobase is not only different, but avoids the stress concentrations of the Petaloid device, thus enhancing impact resistance. Monsanto argues that Continental simply used the Petaloid hollow ribs in combination with the Marcus patent. This requires determination of whether there was something in the prior art

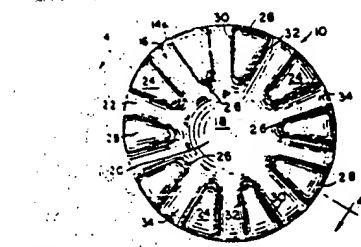


as a whole to suggest the desirability, and thus the obviousness, of making the combination, in a way that would produce the '324 structure. See, e.g., *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Continental argues that it is not apparent, even with hindsight, how any combination of the Petaloid and Marcus patents or other references lead to the '324 base. The Petaloid patent shows concave ribs that extend all the way to the sidewall, while the Marcus ribs extend "from the heel" toward an annular central ring. The Petaloid base has wide, petal-like, open ribs, while Marcus shows narrow, beam-like ribs. The deposition testimony was in conflict as to the inferences drawn from the references.

On this disputed issue, drawing reasonable inferences in favor of the non-movant, it has not been established that one skilled in the art would be motivated to select and combine features from each source in order to make the '324 base. *Interconnect Planning*, 774 F.2d at 1143, 227 USPQ at 551 ("When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself").

The Decaloid Patent

The district court also referred to combination of the Decaloid base with the Marcus base. The Decaloid base has ten hollow ribs that extend to the sidewall, and ten feet between the ribs:

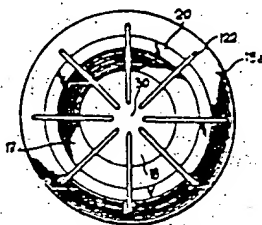


Monsanto does not explain, and we can not discern, how the combination with Marcus would have led a person of ordinary skill to the '324 base. The court's summary holding of obviousness based on these references, separately or in combination, can not be sustained.

The Colombo Patent

The Colombo base, like the Petaloid and Decaloid bases, has hollow ribs that extend to the sidewall, in a still different structure from that of Marcus and also from that of the '324 patent. Colombo describes his ribs as inverted U-shapes, concave, located on the outer surface of the central concavity:

Fig. 4



Again, drawing reasonable factual inferences in favor of Continental, and in the absence of any suggestion or motivation in the prior art as a whole to make a selective combination of the Colombo and Marcus structures along with other changes needed to obtain the '324 structure, summary judgment of obviousness was inappropriate.

The district court found that there was no substantial difference between the '324 invention and the combined teachings of the prior art:

As obviousness can be established on the basis of the combined teachings of references, we think it is clear that simple enhancements of existing prior art, i.e., inverting the '270 petaloid base, do not constitute a substantial difference between the subject matter claimed in the '324 patent and that of the prior art. Thus, the facts of this case reveal no substantial difference between '324 and the prior art.

Continental, 11 USPQ2d at 1769 (citation omitted). However, as we have discussed, the criterion of § 103 is not whether the differences from the prior art are "simple enhancements", but whether it would have been obvious to make the claimed structure.

Objective Indicia

The district court concluded that the structure in suit is simply a variation on known themes. It is in such circumstance that the objective indicia — the so-called secondary considerations — are most useful to the decision-maker. The significance of a new structure is often better measured in the marketplace than in the courtroom.

[6] Thus when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the decision-maker must consider the obviousness of the new structure in this light. Such objective indicia as commercial success, or filling an existing need, illuminate the technological and commercial environment of the inventor, and aid in understanding the state of the art at the time the invention was made. See *In re Piasecki*, 745 F.2d 1468, 1475, 223 USPQ 785, 790 (Fed. Cir. 1984) (secondary considerations "often establish that an invention appearing to have been obvious in light of the prior art was not" (quoting *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-39, 218 USPQ 871, 879 (Fed. Cir. 1983))).

Continental licensed the '324 counterpart Japanese patent to a Japanese company, Yoshino, that we are told had been unable to develop a plastic bottle for hot-fill applications. A witness for Toyo Seikan, another Japanese licensee, testified that the Conobase "sustains itself in higher temperatures, and it does not cause buckling after you fill [the bottle]", as compared with previously available plastic bottles. Continental asserts that Monsanto had been unable to develop a satisfactory bottle for hot-fill applications, and had therefore obtained this technology from Yoshino.

[7] The district court acknowledged the commercial success of the Conobase, but stated that "we are not convinced that the conobase alone accounts for any of the success." 11 USPQ2d at 1770 (emphasis in original). The court suggested that the commercial success in Japan was due to the market strength of the Japanese licensee, and held that there is no nexus between the merits of the product and its commercial success. It is not necessary, however, that the patented invention be solely responsible for the commercial success, in order for this

al, 11 USPQ2d at 1769 (citation). However, as we have discussed, the of § 103 is not whether the difference in the prior art are "simple enhancements" but whether it would have been to make the claimed structure.

Objective Indicia

The district court concluded that the issue in suit is simply a variation on themes. It is in such circumstance that objective indicia — the so-called secondary considerations — are most useful to the decision-maker. The significance of a structure is often better measured in the marketplace than in the courtroom.

Thus when differences that may appear logically minor nonetheless have a significant impact, particularly in a crowded marketplace, the decision-maker must consider the newness of the new structure in this light. Objective indicia as commercial success, filling an existing need, illuminate technological and commercial environment of the inventor, and aid in understanding the state of the art at the time the invention was made. See *In re Piasecki*, 745 F.2d 1468, 1475, 223 USPQ 785, 790 (Fed. Cir. 1984) (secondary considerations "often show that an invention appearing to have been obvious in light of the prior art was not"). See *Stratoflex, Inc. v. Aeroquip Corp.*, 725 F.2d 1530, 1538-39, 218 USPQ 871, 879 (Fed. Cir. 1983)).

Continental licensed the '324 counterpart patent to a Japanese company, no, that we are told had been unable to develop a plastic bottle for hot-fill applications. A witness for Toyo Seikan, another licensee, testified that the Conobase sustains itself in higher temperatures and does not cause buckling after you fill the bottle, as compared with previously available plastic bottles. Continental asserts that Monsanto had been unable to develop a factory bottle for hot-fill applications and had therefore obtained this technology from Yoshino.

The district court acknowledged the commercial success of the Conobase, but found that "we are not convinced that the success alone accounts for any of the success." 11 USPQ2d at 1770 (emphasis in italics). The court suggested that the commercial success in Japan was due to the market strength of the Japanese licensee, and held that there is no nexus between the success of the product and its commercial success. It is not necessary, however, that the invention be solely responsible for the commercial success, in order for the

factor to be given weight appropriate to the evidence, along with other pertinent factors. See generally *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392-94, 7 USPQ2d 1222, 1226-28 (Fed. Cir.), cert. denied, 488 U.S. 956 (1988); *Rosemount, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 1546, 221 USPQ 1, 7 (Fed. Cir. 1984). Monsanto also states that the Conobase is different from the '324 invention, so that even were the Conobase successful, this does not inure to the benefit of the '324 patent. It is apparent that the factual issues surrounding the objective indicia were disputed, and material.

In view of the material facts requiring resolution, the issue of obviousness was not properly decided on motion for summary judgment. We vacate the grant based on 35 U.S.C. § 103, and remand for trial of this issue and the other issues remaining in the case.

Costs

Costs in favor of Continental.
REVERSED IN PART, VACATED IN PART, and REMANDED

U.S. Patent and Trademark Office Trademark Trial and Appeal Board

In re Pennzoil Products Co.

Serial No. 73/670,049

Decided August 21, 1991

Released October 10, 1991

TRADEMARKS AND UNFAIR TRADE PRACTICES

1. Types of marks — Descriptive — In general (§327.0301)

A term is considered to be merely descriptive of goods or services, within meaning of Trademark Act's Section 2(e)(1), if it immediately describes ingredient, quality, characteristic, or feature or if it directly conveys information regarding nature, function, purpose, or use of such goods or services; term need not describe all properties or functions of goods or services, but rather is merely descriptive if it describes significant attribute of goods or services.

2. Types of marks — Descriptive — Particular marks (§327.0303)

"MULTI-VIS" is merely descriptive of multiple viscosity motor oil, regardless of

whether applicant may have been first to use such term, and/or is currently only entity using term.

3. Types of marks — Generic — Particular marks (§327.0603)

"MULTI-VIS," as applied to multiple viscosity motor oil, is generic and incapable of registration, despite form declarations from nine marketers of automotive oil products as to significance of term; applicant's extensive promotional expenditures, unit sales, product revenues, and position of sales leadership in motor oil are insufficient to demonstrate that "MULTI-VIS" is either promoted as mark or perceived as one by purchasing public.

Appeal from refusal of registration (Fred Mandir, examining attorney; Thomas Howell, managing attorney).

Application for registration of trademark of Pennzoil Products Co., serial no. 73/670,049, filed July 6, 1987. From refusal of registration, applicant appeals. Affirmed. Frederick B. Ziesenheim, of Webb, Burden, Ziesenheim & Webb, Pittsburgh, Pa., for applicant.

Before Cissel, Quinn, and Hohein, members.
Hohein, member.

An application has been filed by Pennzoil Products Company to register "MULTI-VIS" for "multiple viscosity motor oil".

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's goods, the mark is merely descriptive of them. Although applicant, in response, amended the application to seek registration pursuant to the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), registration thereunder has also been finally refused on the ground that the evidence of acquired distinctiveness is insufficient since the term "MULTI-VIS" is generic or so inherently and directly descriptive of applicant's goods as to be incapable of registration.²

¹ Ser. No. 73/670,049, filed on July 6, 1987, which alleges dates of first use of April 28, 1953.

² Such refusal was expressed in the Office Action of April 4, 1990 as follows:

The refusal of registration on the ground that the evidence presented fails to demonstrate de jure secondary meaning under Section 2(f) is proper. The proposed mark MULTI-VIS is generic or so highly descriptive as to be incapable of registration.

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